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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/820,747	04/09/2004	Je-hyoung Ryu	1572.1241	8808
21171	7590	11/22/2005	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			NGHIEM, MICHAEL P	
			ART UNIT	PAPER NUMBER
			2863	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/820,747

Applicant(s)

RYU ET AL.

Examiner

Michael P. Nghiem

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 September 2005.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☒ Claim(s) 17 and 18 is/are allowed.
6) ☒ Claim(s) 1,3-5,10,12 and 15 is/are rejected.
7) ☒ Claim(s) 2,6-9,11,13,14 and 16 is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 09 April 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8-5-05.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

The Amendment filed on September 16, 2005 has been acknowledged.

Drawings

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the elastic member **connecting the contact block and the lead pusher** (claim 11) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner,

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the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 4, 10, 12, and 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee et al. (2005/0012498).

Regarding claim 1, Lee et al. discloses an inspecting apparatus (Fig. 1) for a semiconductor device (paragraph 0024, line 2) comprising:

- a match plate (357);
- a contact module (355) combined with the match plate (paragraph 0076, lines 5-7), the contact module comprising:
 - a radiator (403) to contact the semiconductor device (paragraph 0082, lines 4-

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5), and a tester (comprises 300) to contact leads (361) of the semiconductor device (paragraph 0070, lines 1-3), and a thermally conductive pad (conductor, paragraph 0018, line 13) installed on a contacting face of the radiator, to transfer heat from the semiconductor device to the radiator (paragraph 0018, lines 12-19).

Regarding claim 3, Lee et al. discloses that the thermally conductive pad is compressible (conductor is deemed to be compressible).

Regarding claim 4, Lee et al. discloses that the thermally conductive pad is compressible from 1-2 mm (if an adequate force is applied to the conductor).

Regarding claim 10, Lee et al. discloses that the radiator comprises:

- a heat sink (403);
- a contact pusher (350) to contact the semiconductor device having the thermally conductive pad attached to a contacting face (paragraph 0076, lines 1-3);
- a heat flat pusher (351) combined with the contact pusher and the heat sink to transfer heat from the semiconductor device to the heat sink via the contact pusher (Fig. 12).

Regarding claim 12, Lee et al. discloses a second elastic member (358) installed between the match plate and the contact block, to allow the contact block to move up and down elastically corresponding to ascent and descent of the match plate, thereby pressing the lead pusher against the leads of the semiconductor device (Fig. 13).

Regarding claim 15, Lee et al. discloses that the second elastic member is a spring (Fig. 13).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee et al. in view of Hirotsuru et al. (US 6,447,894).

Lee et al. discloses all the claimed limitations as discussed above except the thermally conductive pad comprises a ceramic-silicon composite.

Nevertheless, Hirotsuru et al. discloses that a ceramic-silicon composite (column 1, lines 1-2) for the purpose of having excellent thermal conductive characteristic and light weight (column 1, lines 2-4).

Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide Lee et al. with a ceramic-silicon composite as

disclosed by Hirotsuru et al. for the purpose of having excellent thermal conductive characteristic and light weight.

Allowable Subject Matter

Claims 2, 6-9, 11, 13, 14, and 16 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 17 and 18 are allowed.

Reasons For Allowance

The **combination** as claimed wherein the inspecting apparatus for the semiconductor device comprising a plurality of contact modules, wherein the match plate is formed with a plurality of combining holes combinable with the plurality of contact modules (claims 2, 18) or the thermally conductive pad is installed on the radiator using a thermally conductive double-sided adhesive member (claims 6, 7) or a first elastic member installed on the circumference of the heat flat pusher to elastically connect the contact block and the lead pusher (claim 11) or the compressible thermally conductive pad conforms to irregularities of the semiconductor device, preventing air from being present between the thermally conductive pad and the

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semiconductor device when the thermally conductive pad and the semiconductor device are in contact (claim 17) is not disclosed, suggested, or made obvious by the prior art of record.

Response to Arguments

Applicant's arguments filed on September 16, 2005 have been considered but are not persuasive.

With respect to the drawing objection, Applicant argues that Fig. 5c shows the elastic member (80) connecting the contact block (42) to the lead pusher (44).

Examiner's position is that Fig. 5c does not show the elastic member (80) connecting the contact block (42) to the lead pusher (44). Instead, Fig. 5c shows the elastic member (80) connecting **a block above** the contact block (42) to the lead pusher (44).

With respect to the 35 USC 102 rejections, Applicants argue that Lee fails to disclose "a contact module combined with the match plate".

Examiner's position is that Lee discloses a match plate (357) contacting a contact module (355) (paragraph 0076, lines 5-7) (Fig. 9). Thus, clearly, Lee discloses "a contact module (355) combined with (contacting with, Fig. 9) the match plate (357)".

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Nghiem whose telephone number is (571) 272-2277. The examiner can normally be reached on M-H.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (571) 272-2269. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'Michael Nghiem', with a stylized flourish at the end.

**MICHAEL NGHIEM
PRIMARY EXAMINER**

Michael Nghiem

November 20, 2005